

REMARKS

I. The specification has been respectfully corrected.

The specification has been amended to better support the language from claims 2-10 as requested by the USPTO. No new matter has been added.

II. The 112 rejections have been addressed.

These were amendments made for antecedent basis reasons only and are not narrowing *per se*.

III. Pyyhtia et al. 6,248,990.

Claim 1 has been amended. Support is found at page 3, line 16 and page 1, line 25. The reference does not respectfully teach or suggest the limitations of:

sensing light on a detector with multiple detection channels with an illumination light scan pass so that repeated scanning is dispensed with;

This mainly because Pyytia uses photon counting circuitry for counting plural radiation hits on the associate detector cell, i.e. multiple scan passes and continuous counting circuitry. This loads the sample with unwanted illumination, for example a florescent or living tissue sample has a limited duration and limited illumination capacity.

Therefore, all of the rejections at paragraphs based on this reference alone or in combination are respectfully traversed because this important limitation is not taught or suggested.

Additionally, although the Examiner is respectfully believed to be well versed in the law of obviousness, and combination of references, the relevant law is reproduced below for completeness of the record because the requisite 1. "motivation to combine," 2. "reasonable expectation of success" and 3. "teaching of all the limitations" reasoning was not provided in the previous Office Action as required under 35 USC 103.

In order to establish a *prima facie* case of obviousness under 35 USC 103 according to

be met:

The MPEP Standard for Combining/Modifying References

The Manual of Patent Examining Procedure, section 706.02(j) sets forth the standard for combining and/or modifying prior art, and states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. [Bold emphasis provided.]

VI. New claims 12 and 13 are respectfully submitted for consideration.

No new matter has been added. The claims are supported by the specification.

V. Conclusion.

In light of the *FESTO* case, no argument or amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No claim amendment or argument made was for the purpose of narrowing the scope of any claim unless Applicant has explicitly stated that the argument is "narrowing." It is respectfully requested that all of the claims be reconsidered and allowed. An early and favorable action on the merits is respectfully requested.

Donald H. Hill

Reed Smith LLP
599 Lexington Avenue
New York, NY 10022
Tel. (212) 521-5400

Customer No. 026418
#171254